

REMARKS

Claims 87-139 are pending. No new matter has been added by way of the present amendment. For instance, claim 132 has been amended to more clearly define the enzyme substrate and transferring enzyme. A period has been added to the end of claim 133. Claim 135 has been amended to recite a transsialidase. Claim 137 has been amended to use correct Markush language. Lastly, new claim 139 is directed to a particular enzyme substrate and transferring enzyme. Thus, no new matter has been added.

In view of the following remarks, the Examiner is respectfully requested to withdraw all rejections and allow the currently pending claims.

Objection to Claim 133

The Examiner has objected to claim 133 for lacking a period at the end. Applicants have corrected this issue, thus, this objection is moot.

Issue under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claim 137 under 35 U.S.C. § 112, second paragraph for the reasons recited at page 3 of the outstanding Office Action. In particular, the Examiner asserts that the phrase "such as" render the claim indefinite. Applicants traverse and submit that claim 137 has been amended to remove this phrase. This rejection is thus moot.

Issues under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 132-136 and 138 under 35 U.S.C. § 112, first paragraph asserting that there is a failure to comply with the written description requirement. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the present invention embodies the novel concept of enzyme substrates capable of being transferred to another entity. Further, the terms “enzyme,” “substrate” and “covalent linkage” are terms commonly used in the art and therefore perfectly understood by those of skill in the art, such person being capable of understanding and designing various enzyme substrates.

However, in order to further prosecution, the term “enzyme substrate” has been amended to refer to a 2-modified monosaccharide or a modified monosaccharide residue and the “enzyme” has been amended to refer to glycosyltransferases or transglycosylating enzymes. Such “enzyme substrates” belong to a limited and well-defined group of carbohydrates exemplified in the present specification. The enzyme specificities are known in the art and based upon the present disclosure, one of skill in the art would have understood that Applicants were in possession of such at the time of filing. Moreover, a skilled person in the art can design suitable monosaccharide derivatives for such reasons. Also, the term “monosaccharide” is a structural definition and the phrase “capable of being transferred in a transferase reaction” combine specific structural and functional characteristics. Therefore, although the Examiner has referenced various written description cases (e.g., University of California v. Eli Lilly, and Enzo Biochem v. Gen-Probe), the presently claimed subject matter is distinguished from such cases since the specific structure of a “monosaccharide” is well known, without need for description of a myriad of species. Simply put, a “monosaccharide” defines what the molecule “is” rather than what it “does” and thus the above cited cases are inapplicable to the present facts. Such cases are made even more inapplicable due to the specific functional language also referenced above.

Moreover, with regard to the 2-modified monosaccharide residues, glycosyltransferase and transglycosyltransferase, Applicants respectfully submit that there is a sufficient amount of examples that will allow a skilled professional to understand that Applicants were in possession of the claimed subject matter. The Examiner is therefore respectfully requested to withdraw this rejection.

Issues under 35 U.S.C. § 102

The Examiner has rejected claims 132-136 and 138 under 35 U.S.C. § 102(b) as being anticipated by Butler et al. Applicants respectfully traverse this rejection.

The Butler reference describes position 6-modified glycosyltransferase substrates. In contrast, the present 2-modified monosaccharide structures are clearly distinct from Butler. For a rejection to constitute "anticipation", all material elements of a claim must be found in the cited art reference. In re Marshall, 577 F.2d 301, 198 U.S.P.Q. 344 (CCPA 1978). In view of the above distinction, Applicants submit that there exists no anticipation based upon Butler. The Examiner is therefore requested to withdraw this rejection.

The Examiner has also rejected claims 132, 134-136 and 138 under 35 U.S.C. § 102(e) as being anticipated by Saarinen et al. Applicants respectfully traverse this rejection.

Applicants point out that Saarinen et al. describe transfer of galactosamine, which is a monosaccharide, but not a modified monosaccharide as presently claimed. Therefore, there is no anticipation based upon Sarrinen et al. The Examiner is therefore requested to withdraw this rejection.

Application No.: 10/525,011
Response to Office Action dated September 9, 2008

Docket No.: 0933-0236PUS1
Art Unit: 1642


In view of the above, Applicants respectfully submit that the examined claims are in condition for allowance. The Examiner is therefore requested to withdraw all rejections and allow the examined claims.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Craig A. McRobbie, Registration No 42,874, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: March 9, 2009

Respectfully submitted,

f By  42-874

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